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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,160	09/22/2003	Eduard K. de Jong	P8727	1672

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EXAMINER	
HOMAYOUNMEHR, FARID	
ART UNIT	**PAPER NUMBER**
2132	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/669,160	DE JONG, EDUARD K.	
	Examiner	Art Unit	
	Farid Homayounmehr	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-86* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-86* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *multiple*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims **1-86** have been examined.

Information Disclosure Statement PTO-1449

1. The Information Disclosure Statement submitted by applicant on 12/29/2003, 4/13/2004, 4/20/2004, 6/27/2005, 7/17/2006 and 12/4/2006 have been considered. Please see attached PTO-1449.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See, *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1/130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 10-13, 19-22, 28, and 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 5 of U.S. Patent Application Publication No. 2004/0064717 (de Jong et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because de Jong discloses:

de Jong claim 1: A method for digital content access control, the method comprising: sending a digital content request comprising a request for digital content to a content provisioner capable of authenticating said request; receiving an authenticated digital content request in response to said digital content request; and sending said authenticated digital content request to a content repository that provides storage for said digital content.

de Jong claim 3: The method of claim 1 wherein said digital content request comprises a Universal Resource Locator (URL); and said authenticated digital content request comprises a tokenized URL.

de Jong claim 5: The method of claim 4 wherein said token is from a token pool associated with the location of digital content for which access is authorized.

Claims 1, 10, 19, and 28 of the instant application are obvious over claims 1 and 3 above, as they produce a method for digital content access control, comprising: receiving a digital content request comprising a request for digital content; creating an authenticated digital content request if a user associated with said digital content request is authorized to access said digital content; determining one or more delivery parameters, said one or more delivery parameters identifying a target device to receive said digital content; and sending said authenticated digital content request including said one or more delivery parameters.

Claims 2, 3, 11, 12, 20-21, 30-31 of the instant application are obvious over claims 1, 3 and 5 above, as they produce limitations of claim 1 and wherein said digital content request comprises a Universal Resource Locator (URL); said authenticated digital content request comprises a tokenized URL; and said creating further comprises: determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token.

Claims 4, 13, 22 and 32 of the instant application are obvious over claims 1, 3 and 5 above, as they produce limitations of claim 1 and wherein said token is from a token pool associated with the location of digital content for which access is authorized.

4. This obviousness-type double patenting is not a provisional rejection as the conflicting claims have in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 5 recites the limitation "said content repository". There is insufficient antecedent basis for this limitation in the claim. Content repository is not identified in claim 1 or 5 and it is unclear what element is being synchronized with the content repository.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 10, 19 and 28 rejected under 35 U.S.C. 102(e) as being anticipated by Muntz et al. (US Patent Application Publication No. 2003/0208681, filed May 6, 2002).

9.1. As per claims 1, 10, 19 and 28 Muntz is directed to a method for digital content access control, comprising: receiving a digital content request comprising a request for digital content (Fig. 5A and associated text, and in particular paragraph 39); creating an authenticated digital content request (Fig. 3 and associated text describes creation of a block list and a token identifying the resource to be accessed, the operations that could be performed on the resource and the user credentials) if a user associated with said digital content request is authorized to access said digital content (for example, paragraph 31); determining one or more delivery parameters, said one or more delivery parameters identifying a target device to receive said digital content (the block list and the token determine access parameters and credentials of the user and the client device); and sending said authenticated digital content request including said one or more delivery parameters (paragraph 19).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 2-9, 11-18, 20-27 and 29-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muntz et al. (US Patent Application Publication No. 2003/0208681, filed May 6, 2002).

11.1. As per claim 2, Muntz is directed to the method of claim 1 wherein said digital content request comprises a Universal Resource Locator (URL); said authenticated digital content request comprises a tokenized URL; and said creating further comprises: determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token (Muntz teaches identification of the resource to be accessed using a token and a block list as identified in rejection of claim 1. Examiner takes the official notice that a common and widely practice mechanism to identify a resource and credentials needed to access the resource is using URLs and tokenized URLs. It would have been obvious to a person skilled in art to use a tokenized URL as a mechanism to implement Muntz block list and token).

11.2. As per claim 3, Muntz is directed to the method of claim 2 wherein said tokenized URL further comprises a cryptogram based at least in part on an identifier that describes the location of said digital content (Muntz teaches creating a encryption of the token and the block list in paragraph 39. Note that the token and/or the block list include

information that identifies the resource, and therefore once encrypted, creates a cryptogram based on characteristics of the resource).

11.3. As per claim 4, Muntz is directed to the method of claim 2 wherein said token is from a token pool associated with the location of digital content for which access is authorized (generation or selection of tokens from a token pool to identify and describe the resource to be accessed was well-known at the time of invention).

11.4. As per claim 5, Muntz is directed to the method of claim 1, further comprising synchronizing with said content repository if synchronization is enabled (paragraph 23 teaches synchronization with the resource storage during authorization process).

11.5. As per claim 6, Muntz is directed to the method of claim 1 wherein said one or more delivery parameters comprises a serial number uniquely identifying said target device (paragraph 23 shows the credentials of the user and the client device are part of the authorization combination).

11.6. As per claim 7, 8 and 9 Muntz is directed to the method of claim 1, which describes a method for access control to digital data and determining whether the client is authorized to access data. After the access authorization is determined, the next step is secure delivery of digital content. Examiner takes the official notice that use of a token to specify and communicate the parameters associated with the content delivery

encryption protocol, such as the cryptographic process and methods to derive keys for encryption and decryption was well-known at the time of invention.

11.7. Limitations of claims 10-32 are substantially the same as limitations of claims 1-9 above.

11.8. As per claim 33, Muntz is directed to a method for digital content access control, comprising: receiving an authenticated digital content request including one or more delivery parameters (Fig. 3 item 216 and Fig. 5B and associated text shows reception of an authenticated digital content request by a block server), said authenticated digital content request based at least in part on a digital content request comprising a request for digital content (see response to claim 1); validating said authenticated digital content request, said validating comprising indicating said authenticated digital content request is valid if said authenticated digital content request is validly associated with said digital content and if said authenticated digital content request authenticates said digital content request (paragraphs 27-29); determining a session key if said authenticated digital content request is valid (paragraph 28), said determining comprising: determining a target key based at least in part on a target ID, said target ID identifying a target device; and applying a cryptographic process to a first key based at least in part on at least part of said authenticated digital content request together with said target key to create said session key; encrypting said digital content using said session key; and sending said encrypted digital content (as mentioned in response to claim 1, creation of

a session key to encrypt the digital content for secure delivery to a target device was well-known and commonly used at the time of invention).

11.9. As per claims 33 and 34, creation of the session key based on another master key and parameters identified in a token were well-known at the time of invention.

11.10. Limitations of claims 35-41 are substantially the same as limitations of claims 1-9 and 33-35 above.

11.11. As per claim 42-45 Muntz is directed to the method of claim 33 wherein said validating further comprises: receiving a token; indicating said token is invalid if said token is not associated with an partially redeemed or unredeemed offset within a token offset window, said token offset window comprising one or more offset entries identified by a base number and an offset from said base number, said one or more offset entries associated with a token in a token pool formed by applying a cryptographic process to the sum of said base number and said offset from said base number, together with a token chain key, said token pool associated with said digital content; and updating the offset entry associated with said token and indicating said received token is valid if said token is associated with a partially redeemed offset or unredeemed offset within said token offset window (Muntz is directed to limitations of claim 33 as discussed above. The additional limitations are directed to a method of checking the validity of a token selected from a token pool, wherein the token pool is associated with a digital content

for controlling user access. Examiner takes the official notice that this method was well known in the art at the time of invention, and it would have been obvious to the person skilled in art to use the method to control and limit user access to digital data).

11.12. Limitations of claims 46-86 are substantially the same as limitations of claims 1-45 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is 571 272 3739. The examiner can normally be reached on 9 hrs Mon-Fri, off Monday biweekly.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

Examiner

Art Unit: 2132

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